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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/717,576

11/21/2000

John F. Fairclough

TRO4-BK25

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06/06/2005

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1920 MAIN STREET
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EXAMINER

WINTER, JOHN M

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/717,576

Applicant(s)

FAIRCLOUGH ET AL.

Examiner

John M Winter

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-11,16-19 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-19 and 23-26 is/are allowed.
- 6) ☒ Claim(s) 1 and 4 is/are rejected.
- 7) ☒ Claim(s) 3,6,7 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Status

Claims 1,3-7 9-11, 16-19 and 23-26 remain pending

Response to Arguments

The Applicants arguments filed on March 25, 2005 have been fully considered. The amended claims are rejected in view of the newly discovered references Walker et al. (US Patent 6,338,049).

The Simonoff (US Patent 6,611,351) has been withdrawn.
See following rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pare, Jr. et al. (US Patent No 6,230,148) in view of Walker et al. (US Patent 6,338,049).

As per claim 1,

Pare Jr. et al. ('148) discloses a method for printing and verifying checks over a network comprising the following steps:

- connecting a client computer to a merchant server at a location remote from the client computer;(column 14, lines 34-42)
- transmitting an order from the client computer to the merchant server; (figure 4)
- selecting payment by check; (figure 6)
- connecting the client computer to a check server;(column 13, lines 66-67; column 14, lines 1-19)
- inputting customer data at the client computer; (column 13, line 64)
- transmitting customer data from the client computer to the check server; (column 13, line 66-67; column 14, lines 1-2)
- transmitting customer data from the check server to a check verification

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server; (column 15, line 1-7)

transmitting an approval from the check verification server to the check server (column 15, line 1-7)

Pare Jr. et al. ('148) does not explicitly disclose printing a check including data from the check server as a negotiable instrument at a remote location. Walker et al ('049) discloses printing a check including data from the check server as a negotiable instrument at a remote location. (Column 6, lines 9-20) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Walker et al ('049) method in order to allow the seller to generate physical proof of the transaction.

As per claim 4,

Pare Jr. et al. ('148) discloses the method of Claim 1

Pare Jr. et al. ('148) does not explicitly disclose the check is printed by a secure printer connected to a check printing station at the remote location. Walker et al ('049) discloses the check is printed by a secure printer connected to a check printing station at the remote location (Figure 2C). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Walker et al ('049) method in order to allow the seller to generate physical proof of the transaction.

Claim 5, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pare, Jr. et al. (US Patent No 6,230,148) in view of Hills et al. (US Patent No 6,164,528)

As per claim 5,

Pare Jr. et al. ('148) discloses the method of Claim 1

Pare Jr. et al. ('148) does not explicitly disclose storing the approval from the check verification server in a merchant file in the check server; downloading the merchant file from the check server to a check printing station. Hills et al. ('528) discloses storing the approval from the check verification server in a merchant file in the check server; (Abstract) downloading the merchant file from the check server to a check printing station (Column 12, lines 54-67) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Hills et al. ('528) method in order to protect the merchant from fraud caused by a customer with insufficient funds to cover the check.

As per claim 9,

Pare Jr. et al. ('148) discloses the method of Claim 6 where the network is the Internet. (Figure 4)

As per claim 10,

Pare Jr. et al. ('148) discloses the method of Claim 6

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where the approval comprises the customer data transmitted from the client computer to the check server. (column 15, line 1-7)

Allowable Subject Matter

Claims 16-19, 23-26 are allowable over the prior art record.

Claims 3,6,7 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to John Winter whose telephone number is (571) 272-6713. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at (571) 272-6712. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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or faxed to:

| | |
|----------------|--|
| (703) 305-7687 | [Official communications; including After Final communications labeled |
| "Box AF"] | |
| (703) 308-1396 | [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"] |

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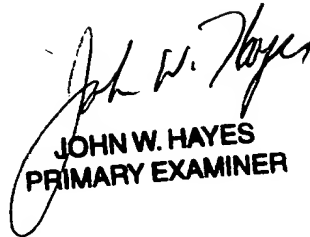
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Hand delivered responses should be brought to the Examiner in the Knox Building, 50
Dulany St. Alexandria, VA.

JMW

May 29, 2005


JOHN W. HAYES
PRIMARY EXAMINER